

REMARKS

In the Office Action dated November 30, 2005, claims 1, 3-9, 12, 15, 19-21, 29 and 30 stand rejected under 35 U.S.C. § 103(a) as obvious U.S. Patent No. 5,061,481 to Suzuki et al. (“Suzuki ‘481”) in view of U.S. Patent No. 4,970,252 to Sakuta et. al (“Sakuta ‘252”). Claims 1, 8, 9, 12, 20 and 21 stand rejected under 35 U.S.C. §103 as obvious over U.S. Patent No. 5,496,554 to Mellul et. al (“Mellul ‘544”) in view of Sakuta ‘252. Claims 1, 8, 10-11, 13-14, 20-21 and 23 stand rejected under 35 U.S.C. §103 as obvious over U.S. Patent No.: 5,853,711 to Nakamura et al. (“Nakamura”) in view of Sakuta ‘252. Claims 1, 15-18 and 30 stand rejected under 35 U.S.C. §103 over U.S. Patent No. 5,236,986 to Sakuta (“Sakuta ‘986”) in view of Sakuta ‘252. Finally, Claim 25 stands rejected under 35 U.S.C. §103 over Suzuki ‘481 and Sakuta ‘252 in view of U.S. Patent No. 6,121,373 (“Starch ‘373”) to Starch.

In view of the above, Applicants have amended claim 1 to further clarify in the body the claim what is meant by “low-temperature stability.” As the Examiner will note, “low-temperature stability” was originally added to the preamble of claim 1 while the test for “low-temperature stability” was added to the body of the claim. However, based on the Examiner’s comments in the office action dated November 30th, Applicants have copied the phrase “low-temperature stability” from the preamble into the body of claim 1 to further clarify the claim language. Applicants submit that this amendment does not narrow the scope of claim 1 because “low-temperature stability” is inherent in the language that already exists in claim 1. The relevant pre-existing language in claim 1 is “wherein said cosmetic, upon inspection by the naked eye, does not exhibit phase separation after storage at 0°C and subsequently returning to room temperature.” Thus, Applicants are only making explicit what is already implicit in claim 1.

Rejections under 35 U.S.C. §103(a)

As noted above, all of the pending claims have been rejected as obvious over the cited prior art. In support of the obviousness rejections, the Examiner relies on *In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972) as to why there is proper motivation to combine the above cited references. At the same time, the Examiner admits that the above-cited prior art does not teach Applicants' "low-temperature stability" but that *In re Linter* somehow cures this deficiency.

In response, Applicants submit that a *prima facie* case has not been set forth regardless of the Examiner's reliance on *In re Linter*. As set forth in Section 2142 of the Manual of Patent Examining Procedure (MPEP.), a *prima facie* case of obviousness requires three basic criteria to be met:

First, there must be some suggestion or motivation either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined), must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, and not on the applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1981)(emphasis added).

However, the Examiner appears to confuse the requirement of motivation or suggestion to combine reference teachings with the separate and distinct requirement that the combined references teach or suggest all the limitations of the claims. While the office action discusses motivation to combine reference teachings, the office action fails to address how the cited prior art teach or suggest two (2) limitations in claim 1, as amended. First, the office action has not set forth how the cited prior art teach or suggest the language in claim 1 of "at least 5 wt% based on the total weight of said cosmetic of an organopolysiloxane expressed by the

following general formula (1)” Second, the office action has not set forth how the cited prior art teach or suggest the language in claim 1 of “wherein said cosmetic, upon inspection by the naked eye, does not exhibit phase separation after storage at 0°C and subsequently returning to room temperature.”

Applicants are also perplexed by the Examiner comments regarding phrase “low-temperature stability” that was originally found only in the preamble of claim 1. This phrase is not a claim limitation because it is only found in the preamble. Prior to the present amendment, this phrase did not appear in the body of claim 1. Although Applicants do agree with the Examiner that the cited prior art does not teach or suggest “low-temperature stability”, which is implicit in the “wherein” clause found in claim 1. In view of the Examiner’s admission, Applicants have decided to redundantly copy this phrase into the body of the claim 1 to explicitly state what is already implicit in the pre-existing claim language.

In addition, Applicants do not see how *In re Linter* corrects the above noted deficiencies with the obviousness rejections. *In re Linter* recites the principle that motivation from the prior art can be completely different from the patent applicant’s motivation. Thus, an Examiner’s rationale for combining reference can be any motivation or suggestion gleaned from the prior art. However, *In re Linter* does not address the failure of the cited prior art to teach or suggest all the limitations of the claims.

In the present application, the cited prior art does not teach or suggest two (2) of the limitations of claim 1. These limitations were added to make the claims commensurate in scope with the experimental data on “low-temperature stability” demonstrated by Applicants’ examples. As a result, these limitations must be considered when determining whether or not there is obviousness. See MPEP §2143.03 (“To establish *prima facie* obviousness of a claimed

invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)").

Moreover, Applicants are perplexed by the Examiner's statement regarding Applicants' showing of non-equivalency regarding the organopolysiloxanes. Applicants have found that organosiloxanes are not functional equivalents when it comes to the stability of cosmetic compositions. This fact was pointed in Applicants' previous amendment that relied on data set forth in the examples of the present specification. Unfortunately, the Examiner has given no weight to Applicants' demonstration of the superior stability through the use of organosiloxanes as required by claim 1. *See* office action at page 11. The Examiner states that "functional equivalency" does not require the compared components to share all features and properties. *See id.* However, Applicants submit that demonstrating superior properties where none is expected from the prior art is evidence of non-obviousness. *See In re Linter*, 458 F.2d at 1008, 173 USPQ at 562 ("A claimed composition may possess unexpectedly superior properties or advantages as compared to prior art compositions. In this way, the conclusion of prima facie obviousness may be rebutted and the claimed subject matter ultimately held to be legally nonobvious.")

In view of the above, Applicants submit that the office action fails to set forth a *prima facie* case of obviousness. The cited prior art fails to teach or suggest two (2) limitations of claim 1. The citation of *In re Linter* does not obviate this deficiency.

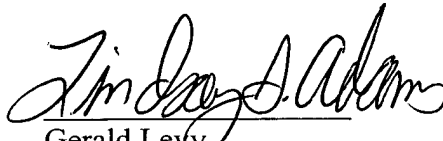
Applicants have also demonstrated an improvement in stability for cosmetic compositions where none is expected from the cited prior art. Such a showing is evidence of unexpected results and demonstrates the non-obviousness of the claimed invention.

Finally, Applicants respectfully request that the Examiner carefully review this case with her Supervisory Patent Examiner, Sreeni Padmanabhan, before issuing a next action.

Applicants strongly believe that the above-noted deficiencies will facilitate a reversal by the Board of Patent Appeals and Interferences if the next action issued is a final office action.

Applicants do not believe that any additional fees are due. However, if any additional fees are due, please charge such sums to our Deposit Account 50-1145.

Respectfully submitted,



Gerald Levy
Reg. No. 24,419

Lindsay S. Adams
Reg. No. 36,425

Attorneys for Applicants

Pitney Hardin LLP
7 Times Square
New York, NY 10036-7311
(212) 297-5800